

REMARKS/ARGUMENTS

Status of the Claims

In the Office Action mailed August 24, 2005, claims 1, 5-17 and 21 are pending. Claims 1, 5-17 and 21 were rejected. The rejection is respectfully traversed. Claims 1, 12 and 17 have been amended. Applicants have thoroughly reviewed the Office Action including the Examiner's remarks and the references cited therein.

The following remarks are believed to be fully responsive to the Office Action. All the pending claims at issue are believed to be patentable over the cited references. Reconsideration and withdrawal of the outstanding rejections are respectfully requested in view of the following remarks.

Entry of the amendments is proper under 37 CFR §1.116 since the amendments: (a) place the application in condition for allowance (for all the reasons discussed herein); (b) do not raise any new issues requiring further search and /or consideration; and (c) place the application in better form for appeal (if necessary). No new issues are raised as the amendments merely clarify and/or correct the claims. Accordingly, entry is proper under 37 CFR §1.116.

Claim Rejections 35 U.S.C. §103(a)

Examiner rejected claims 1, 12-14 and 17 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,916,286 to Seashore, *et al.* (hereinafter referred to as "Seashore") in view of U.S. Patent No. 5,956,658 to McMahon. This rejection is respectfully traversed. Without conceding the propriety of the rejection, claims 1, 12 and 17 have been amended. Support for the amendment may be found at least on page 20 and throughout the specification and figures. No new matter has been added.

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. *MPEP*§2142. To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation to modify the references or to combine reference teachings. Second, there must be reasonable expectation of success. Finally, the prior art must teach all the claim limitations. *MPEP*§2142. In light of the following arguments, the combined references do not teach or suggest all of the claim limitations of the present invention. Applicants respectfully point to the final prong of the test which states that the prior art must teach all of the claim limitations. At the very least, the combined references do not teach or suggest all of the limitations of these claims, as stated below.

Claim 1

Seashore does not teach or suggest, at least, *inter alia*, “the graph having a zoomed-in region and a non-zoomed-in region,” as recited in claim 1. Rather, Seashore is directed to a portable diagnostic tool. (Col. 2, lines 65-66). The tool is capable of obtaining the status of an automobile, when connected to it. (Col. 3, lines 1-8). The tool is capable of retrieving trouble codes set in the vehicle. (Col. 6, lines 46-62). However, as the office action so states, Seashore does not disclose, “a list of diagnostic valves wherein an input device can be used to select a diagnostic value to change a placement location of the selected diagnostic value in then an order of the list,” (Page 3). Nor does Seashore disclose a graph, “the graph having a zoomed-in region and a non-zoomed-in region”, as recited in claim 1.

McMahon does not cure the insufficiencies of Seashore. Instead McMahon is directed to a data collection system that includes a hand-held data collector and PC-based Software. (Col. 2, lines 52-65). This data collector is used to collect data on machines on a plant floor. (Col. 2,

lines 38-45). A user may rearrange the list of machines as desired to specify a particular sequence of data collection. (Col. 2, lines 52-65).

“Collected data may be displayed as an amplitude verses time or frequency plot.” (Col. 12, lines 9-15). However, McMahon makes no mention of the ability to closely examine a graph. For instance, McMahon’s data collector does not provide the ability to zoom-in to a particular region of the graph to more fully investigate and analyze the data. Nor does McMahon provide the ability to compare the zoomed-in region with the rest of the data on the graph.

Accordingly, neither Seashore, nor McMahon, alone or in combination, teach or suggest, at least, *inter alia*, “the graph having a zoomed-in region and a non-zoomed-in region” as recited in claim 1.

Claims 5-11 depend from independent claim 1. Because claim 1 is believed to be in condition for allowance, claims 5-11 are also believed to be in condition for allowance, at least by reason of their dependency. Accordingly, withdrawal of the rejection is respectfully requested.

Claim 12

For the reasons previously discussed, neither Seashore, nor McMahon, alone or in combination, teach or suggest, at least, *inter alia*, “and displaying a graph having a zoomed-in region and a non-zoomed-in region,” as recited in claim 12. Claims 13-16 and 21 depend from independent claim 12. Because claim 12 is believed to be in condition for allowance, claims 13-16 and 21 are also believed to be in condition for allowance, at least by reason of their dependency. Accordingly, withdrawal of the rejection is respectfully requested

Claim 17

For the reasons previously discussed, neither Seashore, nor McMahon, alone or in combination, teach or suggest, at least, *inter alia*, “the graph having a zoomed-in region and a non-zoomed-in region” as recited in claim 17. Accordingly, withdrawal of the rejection is respectfully requested.

Claims 5-7, 10 and 21

Claims 5-7, 10 and 21 are rejected under 35 U.S.C. §103(a) as being obvious over Seashore in view of U.S. Patent No. McMahon and in further view of U.S. Patent No. 5,475,399 to Borsuk. Claims 5-7 and 10 depend from independent claim 1 and claim 21 depends from claim 12. Because claims 1 and 12 are believed to be in condition for allowance, claims 5-7, 10 and 21 are also believed to be in condition for allowance, at least by reason of their dependency. Accordingly, withdrawal of the rejection is respectfully requested.

Claims 8 and 9

Claims 8 and 9 are rejected under 35 U.S.C. §103(a) as being obvious over Seashore in view of McMahon in further view of Borsuk and in further view of U.S. Patent No. 5,895,906 to Danielson, *et al.* Claims 8 and 9 depend from independent claim 1. Because claim 1 is believed to be in condition for allowance, claims 8 and 9 are also believed to be in condition for allowance, at least by reason of their dependency. Accordingly, withdrawal of the rejection is respectfully requested.

Claim 11

Claim 11 is rejected under 35 U.S.C. §103(a) as being obvious over Seashore in view of McMahon in further view of Borsuk and in further view of U.S. Patent No. 6,405,049 to Herrod, *et al.* Claim 11 depends from independent claim 1. Because claim 1 is believed to be in condition for allowance, claim 11 is also believed to be in condition for allowance, at least by reason of its dependency. Accordingly, withdrawal of the rejection is respectfully requested.

Claims 15 and 16

Claims 15 and 16 are rejected under 35 U.S.C. §103(a) as being obvious over Seashore and McMahon in further view of U.S. Patent No. 5,541,840 to Gurne, *et al.* Claims 15 and 16 depend from independent claim 12. Because claim 12 is believed to be in condition for allowance, claims 15 and 16 are also believed to be in condition for allowance, at least by reason of its dependency. Accordingly, withdrawal of the rejection is respectfully requested.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully submit that this application is in condition for allowance. Should the Examiner believe that anything further is necessary to place the application in even better condition for allowance, the Examiner is invited to contact the undersigned attorney at 202-861-1746 in an effort to resolve any matter still outstanding before issuing another action.

In the event this paper is not timely filed, Applicants petition for an appropriate extension of time. Please charge any fee deficiencies or credit any overpayments to Deposit Account No. 50-2036 with reference to our Docket No. 87355.1623.

Respectfully submitted,

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